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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/129,298	08/05/1998	CHARLES J. ARNTZEN	7991-023-999	4312

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EXAMINER

KRUSE, DAVID H

ART UNIT	PAPER NUMBER
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1638

DATE MAILED: 11/04/2002

*Handwritten signature/initials*

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

09/129,298

Applicant(s)

ARNTZEN ET AL.

Examiner

David H Kruse

Art Unit

1638

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 11 October 2002 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☒ The period for reply expires 6 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
  - (b) ☐ they raise the issue of new matter (see Note below);
  - (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
  - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.
- NOTE: \_\_\_\_\_.
3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
- The status of the claim(s) is (or will be) as follows:
- Claim(s) allowed: \_\_\_\_\_.
- Claim(s) objected to: \_\_\_\_\_.
- Claim(s) rejected: \_\_\_\_\_.
- Claim(s) withdrawn from consideration: \_\_\_\_\_.
8. ☐ The proposed drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☐ Other: \_\_\_\_\_.

Continuation of 5. does NOT place the application in condition for allowance because: Applicant's arguments have been fully considered but are not deemed to be persuasive. In reference to the rejection of claims 1 and 16 under 35 USC 102(b) as anticipated by Svab et al, Applicant argues that the "recombinagenic oligonucleobase" as defined on page 4 of the Specification obviates the instant rejection. The Examiner responds that recombinagenic oligonucleobases "include" MDON, those molecules taught in "Kmieciak II" and those molecules taught in the listed commonly assigned patent application, but said recombinagenic oligonucleobases do not exclude the molecule taught by Svab et al. Hence, this rejection is maintained. Applicant argues both the rejection under 35 USC 112, first paragraph, for scope of enablement and the rejection under 35 USC 103(a) for obviousness concurrently. Applicant argues, directed to the rejection under 35 USC 112, that the presently claimed process can be used with a high degree of certainty once the gene sequence of a plant is known (page 5 of the Remarks). The Examiner responds that the art teaches that predictability is not certain in the instant case as outlined by Hohn and Puchta (1999) cited in the Office Action mailed 1 March 2002, Applicant confirms this on page 7, last paragraph of the Specification. Applicant argues, directed to the rejection, under 35 USC 103(a), that one of ordinary skill in the art at the time of Applicant's invention would not have expected that one could use biolistic methods to introduce a recombinagenic oligonucleobase into a plant cell to produce a targeted gene mutation as claimed (see page 6 of the Remarks). The Examiner responds that, contrary to Applicant's assertion, one of ordinary skill in the art would have expected such a result, and Applicant has provided no evidence to the contrary. Specifically, claims 1 and 16 do not recite any binding conditions for attaching the recombinagenic oligonucleobase to a particle that would be non-obvious to one of ordinary skill in the art.



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